

REMARKS

Claims 1-8 are pending in this application. Claims 9-13 are cancelled without prejudice.

As a preliminary matter, the Office Action repeatedly refers to SEQ ID NO: 1 as a limitation of the present claims. Applicants assume that this is a typographical error in the Office Action, since the present claims refer to SEQ ID NO: 2, not to SEQ ID NO: 1. The arguments presented below are made on the assumption that all references to SEQ ID NO: 1 were intended to refer to SEQ ID NO: 2.

All of the Present Claims are Entitled to an August 14, 1998 Priority Date.

The Office Action indicated that an English language translation of the German priority application and a declaration under Rule 132 could be used to overcome rejections based on the Zabel *et al.* reference. Submitted herewith is a certified English translation of the German priority Application DE 198 37 015.6. The text of the translated priority application is substantially the same as the text of the present application. Accordingly, all of the present claims are amply supported by the priority application and are entitled to a priority date of August 14, 1998.

The "Declaration Under 37 CFR 132" by inventor Ulrike Zabel, submitted herewith states that Dr. Zabel is a coinventor of the invention described in the present application, along with Harald Schmidt and Wolfgang Poller. Dr. Zabel further states that she and Harald Schmidt were coauthors of Zabel *et al.*, along with Monica Wagner and Mylinh La. As attested in the Declaration, Monica Wagner was an assistant who worked under the direction of Dr. Zabel and Mylinh La was a student who worked under the guidance of Dr. Schmidt. Neither Monica Wagner nor Mylinh La made an inventive contribution to the claims of the present application. Zabel *et al.* is the work of the present inventors and was published after the priority date of the present application. Accordingly, Zabel *et al.* is not available as a reference against the present claims.

Claims 1 and 2 Are Not Anticipated by the Applied References.

Claim 1 has been rejected as allegedly being anticipated by Giuili *et al.* This rejection is unwarranted and should be withdrawn. Claim 1 is directed to an isolated human guanylyl cyclase α 1/ β 1 protein, which is an enzymatically active heterodimer comprising hsGCo1 (having the amino acid sequence of SEQ ID NO: 2) and hsGC β 1 (having the amino acid sequence of SEQ ID NO: 4). Although Giuili *et al.* purport to describe certain α and β

subunits of human guanylyl cyclase, the reference does not describe an enzymatically active heterodimer of hsGC α 1 (SEQ ID NO: 2) and hsGC β 1 (SEQ ID NO: 4). In fact, the sequence for the α chain reported by the reference (see Fig. 2 of Giuili *et al.*) is not the same sequence as SEQ ID NO: 2 of the present application. The amino acid sequence for the α chain in Fig. 2 of Giuili *et al.* includes 717 amino acid residues, whereas SEQ ID NO: 2 includes only 690 residues. Thus, the protein structure reported by Giuili, *et al.* is not the same as the isolated protein of the present claims. Sequence in Fig. 2 of Giuili *et al.* includes a number of specific sequence differences from SEQ ID NO: 2 beginning with amino acid residue 124 and continuing through the end of the sequence. Accordingly, Giuili *et al.* does not teach or suggest the isolated human guanylyl cyclase α 1/ β 1 protein that is presently claimed.

The specific sequence differences between SEQ ID NO: 2 and the Giuili *et al.* sequence are also highlighted in Gencore sequence matching printout for "Result 1" included with the Office Action. In this printout the differences between the database sequence and the Giuili *et al.* sequence are listed as "CONFLICTS". The sequence in the database clearly is NOT the same sequence as reported by Giuili *et al.* in Fig. 2. Furthermore, Giuili *et al.* isolated and sequenced a DNA molecule, not a protein. The present claims are directed to an isolated protein. Clearly, Giuili *et al.* does not disclose an isolated protein having the amino acid residue sequence of SEQ ID NO: 2, and thus, does not disclose all of the limitations of claim 1. Accordingly, Giuili *et al.* cannot anticipate claim 1 of the present application.

The Gencore printout bearing a date of July 2, 2003 also shows that the database sequence, for which the Examiner obtained a 100% match with SEQ ID NO: 2, was modified on May 30, 2000, which is after the priority date of the present application. Thus, this database sequence cannot be used as a reference against the present application. A copy of the Gencore printout with the relevant portions underlined, and a copy of page 85 of Giuili *et al.* with the sequence differences underlined, are attached hereto as Appendix I and Appendix II, respectively, for the convenience of the Examiner.

Claim 1 and 2 were also rejected as being anticipated by Zabel *et al.* Since Zabel *et al.* is not available as a reference against this application, this ground for rejection is moot.

Claims 3-8 Are Not Obvious Over the Applied References.

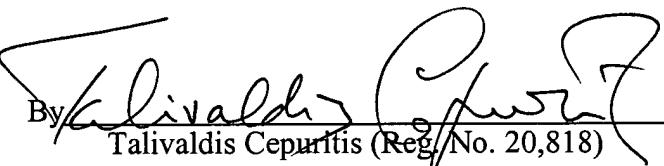
Claims 3-8 have been rejected as purportedly being obvious over either Zabel *et al.* or Giuili *et al.* and further in view of common knowledge in the art regarding methods of affinity chromatography using affinity tags for protein purification. This rejection is also

unwarranted, and is hereby traversed. As noted above, Zabel *et al.* is not available as a reference against the present application. Giuli *et al.* does not teach or suggest an isolated protein having the amino acid residue sequence of SEQ ID NO: 2 as explained hereinabove, which is a material limitation of all of the claims. Accordingly, even assuming common knowledge regarding purification using affinity tags, the combination of Giuli *et al.* with such common knowledge cannot and does not render claims 3-8 obvious. The issue here is not purification, but rather whether or not the claimed isolated protein would have been obvious to one of ordinary skill in the art. A *prima facie* case for obviousness has not been established. The obviousness rejection cannot stand.

Conclusion.

All of the present claims are deemed to be patentable over Giuli *et al.* Reconsideration and entry of this amendment are earnestly solicited. In the event that the foregoing is not deemed persuasive, Applicants request that this amendment be entered to place the application in better form for appeal.

Respectfully submitted,

By 
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Dated August 2, 2004

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Application No. 09/762,767

Amendment Dated: August 2, 2004

APPENDIX I

Pages 1 and 2 of Gencore Search Report labeled "us-09-762-767a-2.rsp" (provided with the Office Action), with underlining added by Applicants to point out significant information in the report relating differences between the database sequence and the sequence of Giuli *et al.*

GenCore version 5.1.6
Copyright (c) 1993 - 2003 Compugen Ltd.

OM protein - protein search, using sw model
Run on: June 27, 2003, 12:55:07 ; Search time 11.0695 Seconds
(without alignments)
2585.358 Million cell updates/sec

Title: US-09-762-767A-2
Perfect score: 3593
Sequence: 1 MFCTKLKDITKTEGCPPSLL.....QKKDVEDGNANFLGKASGID 690

Scoring table: BLOSUM62

Gapop 10.0 , Gapext 0.5

Searched: 112892 seqs, 41476328 residues

Total number of hits satisfying chosen parameters: 112992

Minimum DB seq length: 0

Maximum DB seq length: 2000000000

Post-processing: Minimum Match 0%

Maximum Match 100%

Listing first 45 summaries

Database : SwissProt_40_*

Pred. No. is the number of results predicted by chance to have a score greater than or equal to the score of the result being printed, and is derived by analysis of the total score distribution.

SUMMARIES

Result No.	Score	Query	Match	Length	DB	ID	Description
1	3593	100.0	690	1	CYG3_HUMAN	Q02108	homo sapien
2	3232	90.0	690	1	CYG3_RAT	P19686	ratius norv
3	3107.5	86.5	691	1	CYGD_BOVIN	P19687	bos taurius
4	1651	46.0	730	1	CYGD_RAT	Q9WV11	ratius norv
5	1635	45.5	732	1	CYGD_HUMAN	P33402	homo sapien
6	976.5	27.2	683	1	CYGD_DROME	Q07093	drosoephila
7	795	22.1	619	1	CYGL_RAT	P20595	ratius norv
8	793.5	22.0	619	1	CYGL_BOVIN	P16068	bos taurius
9	789.5	22.0	619	1	CYGL_HUMAN	Q02153	homo sapien
10	774.5	21.6	682	1	CYGL_RAT	P22217	ratius norv
11	708	19.7	617	1	CYGL_HUMAN	Q75443	homo sapien
12	460	12.8	1047	1	ANPB_BOVIN	P46197	bos taurius
13	460	12.8	1047	1	ANPB_HUMAN	P20594	homo sapien
14	460	12.8	1047	1	ANPB_RAT	P16067	ratius norv
15	457.5	12.7	1057	1	ANPA_RAT	P18910	ratius norv
16	456.5	12.7	1061	1	ANPA_HUMAN	P16066	homo sapien
17	454.5	12.6	1057	1	ANPA_BOVIN	P18293	mus musculu
18	452	12.6	433	1	KSGC_RAT	P55285	ratius norv
19	450	12.5	1108	1	CYGE_MOUSE	P15180	mus musculu
20	448	12.4	1109	1	CYGE_RAT	P19179	canis famili
21	445	12.3	1108	1	CYGF_HUMAN	P51841	homo sapien
22	442	12.2	1103	1	CYGF_BOVIN	P002740	bos taurius
23	440	12.2	1108	1	CYGF_RAT	P55203	bos taurius
24	438	12.2	1110	1	CYGD_BOVIN	Q2846	homo sapien
25	438	12.2	1103	1	CYGD_HUMAN	P51839	ratius norv
26	434	12.1	1110	1	CYGX_RAT	P55202	anguilla ja
27	430	12.0	1101	1	ANPB_RAT	P16055	strongyloce
28	428.5	11.9	1050	1	CYGS_SRPRU	P55204	sus scrofa
29	427	11.9	1125	1	HSER_PIG	P25092	homo sapien
30	414.5	11.5	1073	1	HSER_HUMAN	P23897	ratius norv
31	408.5	11.4	1073	1	HSER_RAT	P32897	cavia porce
32	407.5	11.3	1072	1	HSER_CAVPO	P070105	cavia porce
33	399.5	11.1	1076	1			

ALIGNMENTS

RESULT 1							
CYG3_HUMAN	ID	CYG3_HUMAN	STANDARD	PRT:	690 AA.		
Q02108; 043843; 1	AC	Q02108; 043843; 1	26_Created				
01-JUL-1993 (Rel. 39, last sequence update)	DT	30-MAY-2000 (Rel. 39, last sequence update)					
16-OCT-2001 (Rel. 40, last annotation update)	DT						
Guanylate cyclase soluble, alpha-1 chain (EC 4.6.1.2) (GCS-alpha-1)	DE						
(Soluble guanylate cyclase, large subunit) (GCS-alpha-3).	DE						
GUCL1 OR GUCL1A3 OR GUCL3 OR GUCL3A3.	GN						
Homo sapiens (Human); Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi; Mammalia; Eutheria; Primates; Catarrhini; Hominidae; Homo.	OS						
NCBI_TAXID=9606;	OC						
NCBI_TAXID=9606;	OX						
11	RN	SEQUENCE FROM N.A.					
TISSUE=Brain;	RC						
PubMed=9216204; PubMed=1352257;	RX						
Giuill G., Scholl U., Bulle F., Guilleen G.;	RA						
"Human soluble guanylate cyclase large subunit" (Molecular cloning of the cDNAs coding for the two subunits of soluble guanylyl cyclase from human brain)." ;	RT						
RT	RT						
RT	RT						
RT	RT						
304:83-88(1992).	RL						
12	RN	SEQUENCE FROM N.A.					
TISSUE=Kidney;	RC						
PubMed=9816113; PubMed=9742212;	RX						
Ganssemans Y., Brouckaert P., Fiers W.;	RA						
"Human soluble guanylate cyclase large subunit mRNA, alpha3-like." ;	RT						
Submitted (MAY-1996) to the EMBL/GenBank/DBJ databases.	RN						
[3]							
SEQUENCE FROM N.A.	RP						
TISSUE=Brain;	RC						
PubMed=9816113; PubMed=9742212;	RX						
Ganssemans Y., Brouckaert P., Fiers W.;	RA						
"Human soluble guanylate cyclase large subunit mRNA, alpha3-like." ;	RT						
Submitted (MAY-1996) to the EMBL/GenBank/DBJ databases.	RN						
[3]							
Biochem. J. 335:51-57(1998).	RL						
-!- CATALYTIC ACTIVITY: GTP = 3',5'-cyclic GMP + diphosphate.	CC						
-!- ENZYME REGULATION: ACTIVATED BY NITRIC OXIDE IN THE PRESENCE OF MAGNESIUM OR MANGANESE IONS.	CC						
1- SUBUNIT: HETEROODIMER OF AN ALPHA AND A BETA CHAIN.	CC						
-!- SUBCELLULAR LOCATION: Cytoplasmic.	CC						
-!- MISCELLANEOUS: THERE ARE TWO TYPES OF GUANYLATE CYCLASES: SOLUBLE FORMS AND MEMBRANE-ASSOCIATED RECEPTOR FORMS.	CC						
-!- SIMILARITY: BELONGS TO ADENYL CYCLASE CLASS-4/GUANYLYL CYCLASE FAMILY.	CC						
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DR	DR						
EMBL; X66534; CAA7145; -;	DR						
AAB94794; -;	DR						
EMBL; X66534; CAA7145; -;	DR						

APPENDIX II

Page 85 of Giuili *et al.* with portions of the sequence that differ from the Gencore database sequence underlined by Applicants.

Fig. 2. Nucleotide sequence and corresponding protein sequence of GC-Sq₁.